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PTO/SB/64 (10-05)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)

AM100081 01

First named inventor: James J. Gibbons Jr.

Application No.: 09/659,643

Art Unit: 1614

Filed: 09/12/2000

Examiner: Dwayne C. Jones

Title: Method of Potentiating Chemotherapy and Treating Solid Tumors

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity-fee \$ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☒ Other than small entity - fee \$ 1,500.00 (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of a Notice of Appeal and appeal fee (identify type of reply):

- ☐ has been filed previously on _____.
- ☒ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ _____.

- ☐ has been paid previously on _____.
- ☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

06/20/2006 RFEKADU1 00000021 011425 09659643

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Anne M. Rosenblum
Signature

June 16, 2006
Date

Anne M. Rosenblum
Typed or printed name

30,419
Registration Number, if applicable

163 Delaware Avenue - Suite 212
Address

(518) 475-0611
Telephone Number

Delmar, NY 12054
Address

Enclosures: ☒ Fee Payment

☒ Reply

☐ Terminal Disclaimer Form

☒ Additional sheets containing statements establishing unintentional delay

☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

- ☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.
- ☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (571) 273-8300.

Date

Signature

Typed or printed name of person signing certificate



06-19-06

DAK
JFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. AM100081 01)

In re Patent Application of:)
JAMES J. GIBBONS JR. *et al.*)
Filed: 09/12/2000)
For: METHOD OF POTENTIATING)
CHEMOTHERAPY AND TREATING ,)
SOLID TUMORS)

Appl. No.: 09/659,643
Confirmation No.: 6975
Customer No.: 25291
Group Art Unit: 1614
Examiner: Dwayne C. Jones

TRANSMITTAL LETTER

Dear Sir:

Transmitted herewith for filing in the above-referenced patent application are the following items: (1) Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b) (Form PTO/SB/64); (2) Statements in Support of Petition for Revival of an Unintentionally Abandoned Application Under 37 C.F.R. § 1.137(b); and (3) Notice of Appeal from the Primary Examiner to the Board of Patent Appeals and Interferences in duplicate.

The Commissioner is hereby authorized to charge the petition fee as set forth in 37 C.F.R. § 1.17 (m) in the amount of \$1,500.00 and any surcharge to Deposit Account No. 01-1425. A duplicate copy of this letter is enclosed for billing purposes.

Respectfully submitted,

WYETH

Date: June 16, 2006

By: Anne M. Rosenblum
Anne M. Rosenblum
Attorney for Petitioners
Registration No. 30,419

FILING BY EXPRESS MAIL UNDER 37 C.F.R. § 1.10

This correspondence and the accompanying documents identified hereinabove are being deposited with the U.S. Postal Service on June 16, 2006 to be delivered by the "Express Mail Post Office to Addressee" service under Mailing Label Number EQ 077675242 US addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Anne M. Rosenblum
Anne M. Rosenblum



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. AM100081 01)

In re Patent Application of:)	Appln. No.: 09/659,643
)	Confirmation No.: 6975
JAMES J. GIBBONS JR. <i>et al.</i>)	Customer No.: 25291
)	Group Art Unit: 1614
Filed: 09/12/2000)	Examiner: Dwayne C. Jones
)	
For: METHOD OF POTENTIATING)	
CHEMOTHERAPY AND TREATING)	Paper No.: 21
SOLID TUMORS)	

STATEMENTS IN SUPPORT OF PETITION FOR REVIVAL OF AN
UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 C.F.R. § 1.137(b)

Dear Sir:

Petitioners are respectfully requesting revival of the above-referenced application pursuant to 37 C.F.R. § 1.137(b) since the application was unintentionally abandoned as a consequence of an accidental failure to reply to the last Official communication mailed June 27, 2005. In support of the Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b) (Form PTO/SB/64) being filed concurrently herewith, the below statements clearly establish the unintentional delay. Without any question, the abandonment of the application was not a deliberately chosen course of action.

On or around December 27, 2005, the Examiner kindly contacted the undersigned attorney to inquire whether a response to the Official action of June 27, 2005 had been or was being filed, or whether the case was being abandoned. Having no clear knowledge of the action, the attorney double-checked her calendar and searched the file to confirm that she had no record of receiving this action from her corporate client. At the time, she could not verify the status of the action with the inventors or the assignee because the whole company had closed down for the last week of December until January 3, 2006. When the company re-opened for business during the first week of 2006, the undersigned attorney immediately set out to determine if the Office action had been received by the Patent Law Department and/or whether Petitioners had not sent her the Office action because they wanted to abandon the application.

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Upon investigation, it was established that the abandonment of the application was not intentional, that is, the failure to file a timely and proper reply to the action mailed from the U.S. Patent and Trademark Office on June 27, 2005 was absolutely and unequivocally inadvertent. It turned out that docketing staff in the Patent Law Department at Wyeth did safely receive and enter the Office action into the in-house database system but the action was never sent to the undersigned attorney who was responsible as outside patent counsel for handling the prosecution of the case.

It was further learned that the action was received by Wyeth during the regular docketing clerk's vacation and it seemed likely that the usual procedures for mailing the U.S. actions to outside counsel may not have been followed by temporary staff. After asking staff at other corporate locations if they properly received their copies of the action in question, the undersigned attorney discovered that the copy intended for her was sent to the Pearl River facility and placed in its file. No one noticed the extra attorney copy underneath the inventors' Pearl River copy until her inquiry had been made.

To make matters more complicated, the six-month statutory deadline fell on December 27, 2005 during the week when the company completely closed down for a holiday break. Ordinarily, both the in-house counsel assigned to the case and the regular docketing clerk would have sent an e-mail to outside counsel approaching a STAT date, but they were a bit overwhelmed getting a full week of work done in advance of the close-down date and trying to tie up many loose ends before the break as well as the end of the year. Plus, there had been no other apparent reason for the in-house and outside counsel to discuss the case at that point in time. Based on a long-standing relationship of almost twenty years, in-house counsel assumed and trusted that the action had been sent to the undersigned attorney and the response would be filed in due course. As an unfortunate and unintentional result of the misplaced attorney copy of the Office action, however, the fatal due date was missed.

Once it was established that the abandonment was not intentional and an explanation of the reason for the abandonment became evident, any further delay in filing this initial petition pursuant to 37 C.F.R. § 1.137 has likewise not been intentional. Rather, a sufficient amount of time before filing the petition was warranted as a consequence of the statutory mandate under 37 C.F.R. § 1.137(b)(1) that a grantable petition must be accompanied by the reply required to

the outstanding Office action. Operating with due diligence, the undersigned attorney needed the time to analyze the final rejection, study the cited art, research case law with respect to outstanding issues involving the terminal disclaimer and the obviousness rejection, draft memorandum of opinion on case law, confer with in-house counsel, appreciate that the recited structure in Claim 1 was incorrect and determine if correction would be new matter or warranted under the circumstances, resolve the extent of an after final amendment to which the inventors would be willing to accept and discuss same at length with them, decide if the affidavits proposed by the Examiner were necessary, review the M.P.E.P. guidelines and ultimately proceed in a good faith attempt to place the application in condition for an allowance, every task being done towards continuously and persistently seeking revival of the present application within the confines of tending to numerous other urgent business matters and deadlines.

Despite the additional time spent drafting an Amendment Pursuant to 37 C.F.R. § 1.116 that was approved by the inventors, a recent telephone conversation with the Examiner has indicated that the proposed amendment would not suffice to *prima facie* place the application in condition for immediate allowance because it would raise new issues requiring further consideration. Consequently, in lieu of the after final amendment, an Amendment Under 37 C.F.R. § 1.114(c) was drafted to accompany a Request for Continued Examination (RCE) for filing in the U.S. Patent and Trademark Office at the same time as the present petition and required reply (in the form of a Notice of Appeal from the Primary Examiner to the Board of Patent Appeals and Interferences) to expedite matters and advance prosecution towards an allowance.

All in all, this petition, the Notice of Appeal with fee and the RCE with an amendment submission are being diligently filed as soon as realistically and humanly possible.

To enable the Office to readily grant this petition, the following statutory provisions have been satisfied:

37 C.F.R. § 1.137(b)(1): The reply required to the outstanding final Office action mailed June 27, 2005, which is a Notice of Appeal with appeal fee, is being filed concurrently herewith;

37 C.F.R. § 1.137(b)(2): The petition fee of \$1,500.00 as set forth in 37 C.F.R. § 1.17 (m) is being paid by charge to a deposit account and authorized in the cover letter accompanying this petition; and

37 C.F.R. § 1.137(b)(3): It is averred on Form PTO/SB/64 over signature of the undersigned attorney and reiterated that the entire delay in filing the required reply from the due date for the reply until the filing of this grantable petition under 37 C.F.R. § 1.137(b) was unintentional.

Accordingly, it is prayed that this petition be granted and the unintentionally abandoned application be revived to pending status.

Respectfully submitted,

WYETH

Date: June 16, 2006

By: Anne M. Rosenblum
Anne M. Rosenblum
Attorney for Petitioners
Registration No. 30,419

FILING BY EXPRESS MAIL UNDER 37 C.F.R. § 1.10

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